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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,838

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Herman Rodriguez

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/733,838	Applicant(s) RODRIGUEZ ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Claims 1-30 are pending.
2. Examiner notes that Applicant did not challenge the Examiner's citations of Official Notice in the previous Office Action. Therefore, the cited limitations in claims 5, 6, 16, and 22 are taken to be admitted prior art due to the failure to challenge the Examiner's assertions. See MPEP §2144.03 (C).

Claim Objections

3. Claims 12, 14, 18, and 30 are objected to for usage of the functional language "configured to". It is believed that Applicants intend "configured to" to mean "programmed to" since "configured to" is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing "configured to" to "programmed to" where a positive recitation is desired.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-30 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent Application Publication 2002/0174334 ("Meadow").

6. As per claims 1-30, Meadow teaches:
- a. providing a purchaser with an encoded personal identification number (figures 2a, 2b), wherein the PIN is generated when the purchaser makes and offer of payment (Meadow incorporates United States Patent 6,170,744 by reference – see ‘744, Figure 1, reference numbers 110, 120 – the data in 110 is clearly generated at the time of purchase, as the Amount and Payee fields demonstrate);
 - b. receiving the encoded PIN in response to the office of payment by the purchaser to a merchant with a check, by a bank associated with the check, wherein the bank is to decode the encoded PIN (¶0009 – “m-digit customer account number, a p-digit check number, and an r-digit one-way hash value. The r-digit one-way hash value is computed by a one-way hash algorithm that uses the ABA number...”);
 - c. decoding the encoded PIN, comparing the decoded PIN with information associated with the purchaser to authenticate the purchaser (claim 1 – “determining, by the check verifier, if the computed one-way hash value is the same...”);
 - d. verify that sufficient funds are available to the purchaser for the transaction, comparator to compare the transaction amount with funds available to the purchaser for the transaction (the old and well-known (to those skilled in the art at the time of the invention) Telecheck system is envisioned as being used in this system, see ¶0049);
 - e. providing the purchaser with the encoded PIN comprises providing the purchaser with software to generate the encoded PIN, which comprises encrypting a PIN (claim 3 – “a check printer that prints checks based on information provided thereto, the information including a MICR line that includes an ABA number...”);

- f. providing purchaser with encoded PIN comprises interacting with the purchaser to generate the encoded PIN prior to the transaction ('744, figure 1, reference number 110);
- g. receiving transaction information with the encoded PIN, wherein the transaction information comprises a routing number (figure 2b, reference number 110), a bank account number ('744, figure 1, reference number 110), a check number (ibid), and an amount associated with the transaction (ibid);
- h. comparing a password embedded in the decoded PIN against a password received from the purchaser for the transaction ('744, figure 1, reference number 110, field "Invoice", as well as other data);
- i. decrypting the encoded PIN ('744, figure 1, reference number 110, field "Encrypted Data". To be used, encrypted data must inherently be decrypted);
- j. decoding the encoded PIN ('744, figure 1, reference number 110);
- k. encoded PIN comprises using the facts of the offer to encode the PIN ('744, figure 1, reference number 110).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Meadow in view of United States Patent 6,170,744 ("Lee").

1. It is the examiner's primary position that the claims are anticipated because of the above inherent features (i.e. the features which are included by virtue of United States Patent 6,170,744 being included in its entirety, see ¶0004 of Meadow). However, if not inherent, then Lee teaches the above features to provide for a more secure system – "self-authenticating negotiable documents, such as checks...to ensure the integrity and authenticity of the negotiable documents" (column 1, lines 5-15), using an assortment of security features and document printings; note especially those detailed in figure 1. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Meadow the check-based security features (e.g. printing the check amount on the check at the time of purchase) as taught by Lee, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable and advantageous.

Response to Arguments

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s),

the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well.

It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

CCJ

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621